



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,617	04/12/2004	Mark A. Weiss	10379-6U2	3288

570 7590 12/23/2008  
PANITCH SCHWARZE BELISARIO & NADEL LLP  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER
----------

LETT, THOMAS J

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

12/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/822,617

**Applicant(s)**

WEISS, MARK A.

**Examiner**

THOMAS J. LETT

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 10-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2 and 10-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 October 2008 has been entered.

***Applicant-Initiated Interview***

2. In an Applicant-initiated telephonic interview conducted on 16 December 2008 with Applicant's representative Clark Jablon, the participants did not reach an agreement regarding prior art of Chalmers et al as applied to the claims as presented on 29 October 2008.
3. Examiner explained that the 35 USC § 101 rejection remains applicable to the non-statutory printed matter that is claimed in claims 1, 2, and 10-15 which is shown in figures 2A and 2B of Applicant's instant application.
4. Applicant remains in disagreement with Examiner's rejection as illustrated in a figure 1, shown on page 6 of Office action dated 01 May 2008.
5. Examiner has edited said figure 1 and it is shown on page 6 of this Office action. Examiner finds no difference between the prior art of Chalmers et al and Applicant's claim language except the layout of the printed matter.

***Response to Arguments***

6. Applicant's arguments filed 29 October 2008 have been fully considered but they are not persuasive. Examiner has further clarified the location of the amended "blank" region and "marginal" region with a marked-up drawing on page 6 of this communication.

Applicant argues that the prior art does not teach that the blank area and the color bars cover the whole sheet. The prior art shows other data on the sheet that is not blank or a color bar (box for test information and elements 3 and 4 in figure 1, elements 3a and 4a in figure 2).

Examiner responds that the blank region is located where the "lady images" 2 in figure 1 and 2A in figure 2 will be printed, and see col. 9-10. Chalmers et al also disclose that the master/test sheet may (emphasis added) additionally carry image registration symbols (e.g., 3, 3A, 4, 4A and a box for test information), see col. 1, lines 51-55. Examiner has placed markings on the Chalmers figure shown on page 6 of this Office action to better illustrate a "blank" region and a "marginal" region of a sheet of paper. Although Applicant claims that the marginal region is a minor region and the blank area is a major region, Examiner submits that the figure of Chalmers could easily be printed in different arrangements as preferenced by the application. In general, any printed matter may be arranged, laid out, or designed in a manner that would suit the manufacturer and manufacturer's customers.

Applicant has (1) failed to show where the marginal region begins and ends and (2) failed to show where the blank region begins and ends. When Examiner views figures 2A and 2B, the marginal region, *isn't defined or numbered so Examiner will assume marginal region is "10" in fig. 2A and "10" and "20" in fig. 2B, is actually inside of a blank region, that isn't defined so Examiner will assume it is the entire "article of manufacture" or sheet of paper.*

Applicant has introduced other prior art that claim processes and disclose broadly that conventional methods place color bars in a margins. The applied prior art of Chalmers also places color bars printed in a margin outside the area of the printed image. The fact remains that Applicant is claiming a printed sheet of paper but does not clearly define regions. Margins of a page are arbitrarily set on any document depending on the layout created by the user. For example, a user of a word processing application will notice that margins can be set anywhere on a page. Applicant argues against the prior art of Chalmers but the location of the printed matter of Chalmers can be located anywhere on the page based on the layout as long as it doesn't interfere with the image data that is subsequently printed on the proof or test chart.

Applicant further argues that *"there is no use of a proof in Chalmers. The process in Chalmers is used to adjust a printing engine, not to determine if a proof is made that meets industry standards. Since there is no proof used or created in Chalmers, neither the master sheet nor the test sheet (with or without the master sheet image printed thereon) are proofing paper. Thus, no "proofing paper" is provided in Chalmers, as required by the present claims. Stated simply, FIG. 1 of Chalmers merely shows a reference image that is to be printed as part of the calibration process. The reference image in FIG. 1 includes both color bars 1 and color pictures 2. FIG. 1 is not a sheet of proofing paper"*.

Examiner reads proofing paper as Chalmers' paper used for visual inspection. A proof is known in the art to be version of a document or color illustration produced specifically for the purpose of review prior to reproduction. A proof is also known in the art as a test sheet made to reveal errors or flaws, predict results on press and record how a printing job is intended to appear when finished. Chalmers et al satisfy the claim.

The teaching of Chalmers et al is the same as that of the instant application. The purpose of Chalmers et al is to allow a user to compare pre-printed color blocks with

subsequently printed adjacent color blocks in order to ensure that the color quality is acceptably matched, see column 2, lines 6-27. This is also Applicant's purpose as disclosed at page 2, lines 14-20 and page 4, lines 2-6 of the specification.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 2, and 10-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 12 and their dependencies are directed to a sheet of paper with printed color data which are per se not statutory. Data that is pre-printed in certain regions of a page is merely text or image data on a substrate, and the combination does not impart functionality. The printed matter (color bar) in no way depends on the paper, and the paper does not depend on the printed matter.

Chalmers et al disclose the claimed invention except for the specific arrangement (location on the paper, i.e., a marginal area) and/or content of indicia (printed matter) set forth in the claims. It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a wider region to place printed image content does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the cited prior art standardization paper of figure 1 (Chalmers et al) comprising the two regions (blank and marginal) is the same structure claimed by applicant and the sole difference is in the area of placement of the printed material. Thus, there

is no novel and unobvious functional relationship between the printed matter (e.g., color bars) and the substrate (e.g. sheet of paper) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter. Applicant is asked to review 706.03(a) of the MPEP, which states: a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2 and 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chalmers et al (USPN 5,953,990 A).

**Regarding claim 1**, Chalmers et al disclose an article of manufacture for use in a proofing process comprising a sheet of paper (master chart sheet, col. 2, lines 6-9 and see figures 1 and 2. The master chart is an article of manufacture produced from wood or recycled material and ink.) that includes:

(a) a blank region (the blank region where the "lady images" 2 in figure 1 and 2A in figure 2 will be printed, col. 9-10) for subsequent printing of a content image portion (image portion 2A of figure 2); and

(b) a marginal region outside of the blank region (the region outside of Chalmers et al's blank region), the marginal region including one or more standard color bars pre-printed

thereon (color blocks 1 that are printed on the master chart of figure 1), and each of the one or more standard color bars having a plurality of color blocks (e.g., base colors), each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space (e.g., cyan, magenta, yellow, black), wherein the blank region (a) and the marginal region (b) constitute the entire surface area of one side of the sheet of paper ( $a + b$ ).

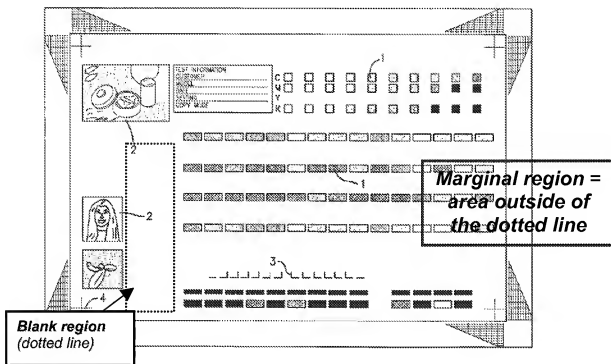


Figure 1 - Standardization Sheet of Chalmers et al

Regarding claim 2, Chalmers et al disclose the article of manufacture sheet of paper of claim 1 wherein marginal region of the sheet of paper further comprises one pre-printed standard color bar (a horizontal arrangement of color blocks 1 that are printed on the master chart of figure 1), the marginal region having a blank area adjacent to the pre-printed color bar for subsequent printing of a second color bar (a horizontal arrangement of color blocks 1A that will be printed as shown in figure 2, the completed result is shown in figure 3 wherein color blocks 1A are just below color blocks 1).



**Regarding claim 10**, Chalmers et al disclose then article of manufacture of claim 1 wherein the marginal region of the sheet of paper is a minor region of the sheet of paper and the blank region is a major region of the sheet of paper. Examiner asserts that the cited prior art standardization paper of figure 1 (Chalmers et al) comprising the two regions (blank and marginal) is the same structure claimed by applicant and the sole difference is in the sizing of the regions of placement of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g., color bars) and the substrate (e.g. sheet of paper) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter. Further, it is user judgment to consider the blank region as being a major region of importance and the marginal region as being a minor region of importance. Applicant does not structurally define the marginal region nor the blank region with any demarcations in the drawings and does not clearly define each region in the specification.

**Regarding claim 11**, Chalmers et al disclose the article of manufacture of claim 1 wherein the sheet of paper is proofing paper (Examiner reads proofing paper as Chalmers paper used for visual inspection. A proof is known in the art to be version of a document or color illustration produced specifically for the purpose of review prior to reproduction. A proof is also known in the art as a test sheet made to reveal errors or flaws, predict results on press and record how a printing job is intended to appear when finished. Chalmers et al satisfy the claim.).

**Regarding claim 12**, Chalmers et al disclose an article of manufacture for use in a proofing process comprising a sheet of paper (a sheet of paper is an article of manufacture) that includes:

(a) a marginal region (the region outside of Chalmers et al's blank region) including one or more standard color bars (color blocks 1 that are printed on the master chart of figure 1) pre-printed thereon, and each of the one or more standard color bars having a plurality of color blocks (e.g., base colors), each color block reflecting a wavelength in the electromagnetic spectrum that represents a color selected from a color space (e.g., cyan, magenta, yellow, black); and

(b) a blank region (the blank region where the "lady images" 2 in figure 1 and 2A in figure 2 will be printed, col. 9-10) outside of the marginal region for subsequent printing of a content image portion (image portion 2A of figure 2), wherein the marginal region (a) and the blank region (b) constitute the entire surface area of one side of the sheet of paper (a + b).

**Regarding claim 13**, Chalmers et al disclose the article of manufacture of claim 12 wherein the marginal region further comprises one pre-printed standard color bar (a horizontal arrangement of color blocks 1 that are printed on the master chart of figure 1), the marginal region having a blank area adjacent to the pre-printed color bar for subsequent printing of a second color bar (a horizontal arrangement of color blocks 1A that will be printed as shown in figure 2, the completed result is shown in figure 3 wherein color blocks 1A are just below color blocks 1).

**Regarding claim 14**, Chalmers et al disclose the article of manufacture of claim 12 wherein the marginal region is a minor region of the sheet of paper and the blank region is a major region of the sheet of paper. The examiner asserts that the cited prior art standardization paper of figure 1 (Chalmers et al) comprising the two regions (blank and marginal) is the same structure claimed by applicant and the sole difference is in the area of placement of the printed material. Thus, there is no novel and unobvious functional relationship between the printed

matter (e.g., color bars) and the substrate (e.g. sheet of paper) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter. Further, it is user judgment to consider the blank region as being a major region of importance and the marginal region as being a minor region of importance.

**Regarding claim 15**, Chalmers et al disclose the article of manufacture of claim 12 wherein the sheet of paper is proofing paper. (Examiner reads proofing paper as Chalmers paper used for visual inspection. A proof is known in the art to be version of a document or color illustration produced specifically for the purpose of review prior to reproduction. A proof is also known in the art as a test sheet made to reveal errors or flaws, predict results on press and record how a printing job is intended to appear when finished. Chalmers et al satisfy the claim.).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 8-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas Lett  
AU 2625

/Edward L. Coles/

Supervisory Patent Examiner, Art Unit 2625